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EXAMINER

FLANIGAN, ALLEN J

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20

Application Number: 09/927,274
Filing Date: August 10, 2001
Appellant(s): OTTER, JAMES WILLIAM

Karin H. Butchko
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

The order by the Board of Patent Appeals and Interferences issued on Nov. 5, 2003 remanding this case to the Examiner has been reviewed and considered.

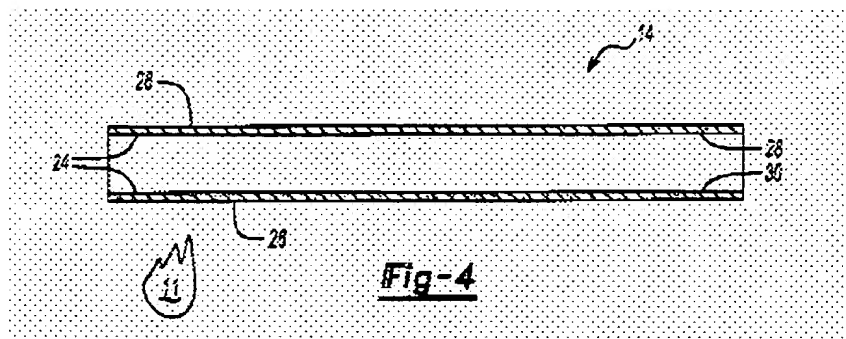
Unfortunately, the Examiner does not have the authority, by himself, to reopen prosecution subsequent to the filing of an Appeal Brief. See MPEP § 1002.02(d)2. It is apparent that the Board desires explanation regarding the

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scope of the claims on appeal in light of the specification. Hopefully, the following will shed some light on the matter.

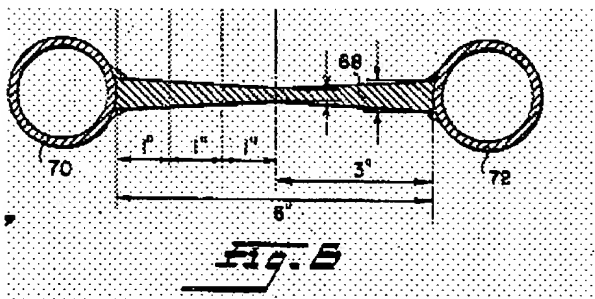
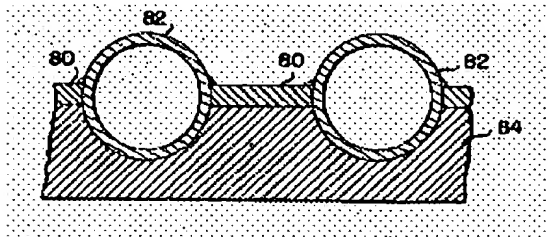
During patent examination, the pending claims must be “given *>their< broadest reasonable interpretation consistent with the specification.” > In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). The Examiner is enjoined to “[apply] to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.” In re Morris, 44 U.S.P.Q. 2d 1023. Limitations from the specification, however, are not to be read into the claims.

In the case of the language at issue in claim 1, the recited "inner surface and an opposing outer surface" language is found in the description of the Fig. 4 embodiment described on page 5, for example. This figure, showing a rectangular element with opposed upper and lower surfaces, is said to illustrate a heat exchanger coated with cupric oxide on "both the inner surface 28 and the outer surface 30":



Thus, although the claim language may not be deemed to be limited to this embodiment, it obviously is meant to encompass the illustrated structure, i.e. an element with opposed upper and lower surfaces coated with an oxidizable material (such as cupric oxide) for enhanced radiation emissivity. In other words, the applicant's own specification makes clear that the language at issue is meant to be readable on a simple exchanger structure having opposed upper and lower surfaces provided with coatings, as shown in Fig. 4 of the drawings.

Compare this with the "radiators 24 shown in Figs.5 and 6 of the Smith, Jr. reference:



As pointed out in column 7 of Smith, Jr., one side of the radiator 24 is coated on surfaces 80 and 82 with an emissive coating. "The side of the radiator opposite the radiant surfaces is preferably coated with an appropriate insulating material 84 to prevent heat losses. *If radiator 24 is employed in an application in which it is disposed between two areas or articles to be heated, insulation 84 is deleted; and a high emissivity coating is applied to both sides of the radiator*" (emphasis added). Thus, in Fig. 5 of Smith, Jr., *both of the opposed upper and lower surfaces of the pipes connected with webbing that make up the radiator would have a coating applied thereto, not (as appellants*

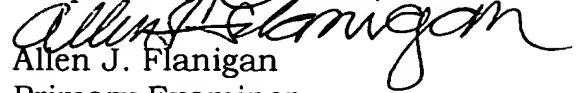
suggest in their brief) simply the upper surfaces 80 and 82. Similarly, in Fig. 6, applying an emissive coating to “both sides of the radiator” in this embodiment as taught by Smith, Jr. would provide a coating on both the upper and lower sides of the web 68 and tubes 70 and 72. Clearly, then, the prior art is describing a structure equivalent to that shown in applicant’s Fig. 4 – a heat exchanger (radiator) with a high emissivity coating applied to both (upper and lower) sides. This was, and remains, the Examiner’s basis for concluding that the language of the claims fails to distinguish over the prior art. In other words, to the extent that the language of claim 1 is readable (as it must be) on the illustrative embodiment of the disclosure said to show “inner” and “outer” surfaces coated with an emissivity enhancing coating, it necessarily must be readable on a structurally indistinguishable showing from the prior art, notwithstanding whatever patina the appellants would like to impart to the terms “inner” and “outer” as used in the claims.

Since this is a supplemental Examiner’s Answer, the Appellants may wish to file a Reply Brief in response hereto, in particular to direct comments to their interpretation of the claim scope as suggested by the Board in order to “develop the application file record with respect to the issue of claim interpretation”. Such a Reply Brief should be filed within two months of this Supplemental Examiner’s Answer; see 37 C.F.R. 1.193.

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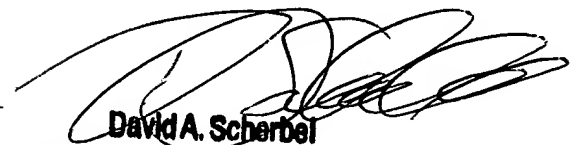
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Respectfully submitted,



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